



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,082	03/10/2004	Mireille Maubou	05725.1274-00	2687
22852	7590	12/18/2008		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER VENKAT, JYOTHSNA A	
			ART UNIT	PAPER NUMBER
			1619	
			MAIL DATE	DELIVERY MODE
			12/18/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/796,082

Applicant(s)

MAUBRU ET AL.

Examiner

JYOTHSNA A. VENKAT

Art Unit

1619

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2, 4-5, 7-9, 27, 32, 36-37, 51, 53, 55, 57, 60-62, 64, 66 and 73 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-849)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Continuation of Disposition of Claims: Claims pending in the application are 1-2, 4-5, 7-9, 27, 32, 36-37, 51, 53, 55, 57, 60-62, 64, 66 and 73.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/2/08 has been entered.

Claims 1- 2, 4-5, 7-9, 27, 32, 36-37, 51, 53, 55, 57, 60-62, 64, 66, 73, and 80-84 are currently pending in the application. Claims 80-84 are withdrawn from consideration being drawn to non-elected subject matter (**election without traverse**) . Generic claims are examined to the extent that it reads on the elected species (calcium carbonate as water-insoluble particle) and polyethyleneimine (cationic polymer of claims 32 and 37).

Claims 1- 2, 4-5, 7-9, 27, 32, 36-37, 51, 53, 55, 57, 60-62, 64, 66 and 73 are currently examined in the application.

Claims 1, 2, 4-5, 7-9, 27,32, 36-37, 51, 53, 55, 57, 60-62, 64, 66, and 73 are rejected under 35 U.S.C. 103(a) as being obvious over the combination of U. S. Patents 6,635,702 ('702) and 5,580,494 ('494) and WO documents WO /2002/096,385 ('385) and WO /2002/096,377 ('377).

WO /2002/096,377 ('377) corresponds to **US 2004/0197355('355)** and WO /2002/096,385 ('385) corresponds to **US 2004/0197356('356)**. Examiner is relying on the **PGPUB documents for teaching of particles claimed.**

The instant application is claiming a cosmetic composition comprising:

1. At least one cross-linked copolymer comprising at least one methacrylic acid unit and at least one C1-C4 alkyl acrylate unit,

2. Polyethyleneimine, and

3. Particles comprising at least 10% by weight of calcium carbonate

4. Silicone (claims 57, 60 and 62)

5. One agent beneficial to keratin material (claims 61 and 64)

6. Surfactant (claim 66)

Patent '702 teaches aqueous surfactant compositions using the ingredients 1, and 4-6. Patent '702 teaches ingredient 1 as a rheology modifier. See the abstract for ingredient 1 and silicone. See col.3, lines 20 *et seq* and see col.4, clo.5, lines 1-40 for the cross-linked polymer which is formed from the two monomers and the cross linking agent. Patent '702 also teaches surfactants at col.5, line 41 to col.6, line 60 and teaches silicones at col.7, ll 25-68. Patent at paragraph bridging col.s 8-9 suggests adding insoluble compounds and this includes claimed calcium carbonate at col.8, line 60. See col.11, ll 50-53 for the additives and these belong to agent beneficial to keratin material like waxes. Patent at col.11, line 41 suggests adding cationic conditioning polymers. This is same as claimed cationic polymer. Patent also teaches the use of these compounds in the compositions in the form of shampoos at col.11, last paragraph. See all the examples. Patent '702 teaches under examples shampoos. Shampoos are for treating keratin material. The difference between the patent and the instant application is the patent '702 does not teach claimed cationic polymer polyethyleneimine or claimed at least 10 % by weight of calcium carbonate.

Patent '494 teaches shampoo compositions using the claimed cationic polymer (polyethyleneimine) along with surfactant. See the abstract, see col.2, ll 20-60 for the cationic polymer and see ll 61-62 for polyethyleneimine and see silicones at col.5, ll 5-45. Patent '494 at col.6, ll 51-62 suggests adding thickeners also known as rheology modifiers to the compositions. See examples.

WO documents teach using 10 % of calcium carbonate in cosmetic compositions and using these compositions for hair.

WO /2002/096,377 ('377) corresponds to **US 2004/0197355('355)**. PGPUB ('355) also teaches cosmetic compositions comprising ingredient 3 and 5-6. See title, see the abstract, see paragraphs 22-31 for ingredient 3 (*Particles comprising at least 10% by weight of calcium carbonate*), see paragraphs 44-70 for ingredient 4 (*Silicone*), see paragraphs 61-80 for the cationic polymer, see paragraphs 35-60 for ingredient 6 (*Surfactant*) and see paragraphs 88, 90 for ingredient 5 (*One agent beneficial to keratin material*) and see paragraphs 93-94 for application of the compositions to keratin material. WO /2002/096,385 ('385) corresponds to **US 2004/0197356('356)**. PGPUB ('356) teaches cosmetic compositions comprising ingredient 3 and 5-6. See title, see the abstract, see paragraphs 21-30 for ingredient 3(*Particles comprising at least 10% by weight of calcium carbonate*), see paragraphs 44-70 for ingredient 4(*Silicone*), see paragraphs 71-91 for the cationic polymer, see paragraphs 35-43 for ingredient 6 (*Surfactant*) and see paragraph 99 for ingredient 5(*One agent beneficial to keratin material*) and see paragraphs 104-105 for application of the compositions to keratin material.

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions of patent '702 and add calcium carbonate and

polyethylenimine (cationic polymer) expecting beneficial effect to the hair. One of ordinary skill in the art would be motivated to add the cationic polymer into the compositions of '702 expecting that the compositions which has the acrylic acid/alkylacrylate polymer provides acceptable rheology without significant increased or decrease in viscosity or pH, with no separation settling with extended periods of time and adding the polyethylenimine into the compositions provide conditioning effects which is excellent for the keratin and adding calcium carbonate particles would provide the additional benefit of better hair style hold and increased sensation of thickness to the hair. This is prima facie case of obviousness.

Response to Arguments

Applicant's arguments filed 12/2/08 have been fully considered but they are not persuasive.

Applicants' argue:

"In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." M.P.E.P. § 2141.02(I) (8th ed. Sept. 2007 Rev.) (emphasis in original) (citations omitted). The '702 patent only broadly discloses, in a laundry list of possible ingredients, cationic polymers which "can optionally be utilized." The '702 patent at col. 11, lines 36-53 (emphasis added). Additionally, insoluble calcium carbonate and clay are just one of many ingredients listed under "other insoluble compounds." The '702 patent at col. 8, lines 54-67. The '702

patent provides no direction as to why or how one skilled in the art would selectively choose cationic polymers or calcium carbonate over other ingredients. Such picking and choosing of elements is improper. See *In re Arkley*, 455 F.2d 586,587 (C.C.P.A. 1972) ("the... reference must clearly and unequivocally disclose the claimed compound or direct those skilled in the art to the compound without any need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference") (emphasis in original).

Further, an examiner must "[c]onsider any teachings of a 'typical,' 'preferred,' or 'optimum' species or subgenus within the disclosed genus." M.P.E.P. § 2144.08. That analysis necessarily includes those exemplified compositions that are dissimilar from those presently claimed: "[s]uch a teaching may weigh against selecting the claimed species or subgenus and thus against a determination of obviousness." M.P.E.P. § 2144.08 (citing *Baird* 16 F.3d 380, 382 (Fed. Cir. 1994)). In this case, none of the seventeen Examples in the '702 patent contain at least one water-insoluble solid mineral particle chosen from clays, particles comprising at least 10% by weight of calcium carbonate as required by the present claims. Further, the Examiner has provided no reason "to select the claimed species or subgenus from the disclosed prior art genus" in the '702 patent. M.P.E.P. § 2144.08 “.

In response to the above argument, patent '702 at col.7, ll 15-25 teaches:

Insoluble Materials or Compounds

The materials or compounds which require stabilization 15
can be soluble or insoluble in water. Such compounds
include insoluble silicones, silicone gums, volatile and non-
volatile silicone oils, pearlescent materials, and other types
of compounds set forth hereinbelow.

Patent at col.8, line 60 **suggests** adding calcium carbonate. See below.

55 Other Insoluble Compounds

In addition to the above generally insoluble compounds,
numerous other optional substantially insoluble compounds
which require stabilization can be utilized. Examples of such
other insoluble compounds include Titanium Dioxide; Pum-
60 ice; Calcium Carbonate; Talc; Potato Starch; Tapioca Starch;
Jojoba Beads; Polyethylene Beads; Walnut Shells; Loofah;
Apricot Seeds; Almond Meal; Corn Meal; Paraffin; Oat
Bran/Oat Hulls; Gelatin Beads; Alginate Beads; Stainless
Steel Fibers; Iron Oxide Pigments; Air Bubbles; Mica
65 Coated Iron Oxides; Kaolin Clay; Zinc Pyrithione; Salicylic
Acid; Zinc Oxide; Zeolite; Styrofoam Beads; Phosphates;
silica, and the like

The expression "optional" means that the calcium carbonate can be present or calcium
carbonate can be absent. The purpose of adding calcium carbonate (insoluble compounds) is to
provide stabilization. Patent at col.9, ll 3-9 teaches:

The amount of the various insoluble compounds requiring :
stabilization will vary depending upon its purpose, desired :
end result, and efficacy thereof. Hence amounts can vary 5 :
widely, but frequently will be within a general range of from :
about 0.1% to about 50% by weight based upon the total :
weight of the stable composition.

Applicant's attention is drawn to example 3B which has insoluble components mica, titanium dioxide and iron oxide. Example 4A has Jojoba beads and all these compounds were taught by patent at col.8, ll 55-68. The examples may not teach calcium carbonate but the examples definitely direct one skilled in the art to choose functional equivalent since substituting calcium carbonate would also produce stable formulations. PG PUB clearly teaches claimed 10 % weight of calcium carbonate provide hair with texture and better hairstyle hold. see below for paragraph [0011] of PG PUB '355.

[0011] The Applicant has discovered, surprisingly and unexpectedly, that by carefully selecting the surfactant base and the conditioner, combined with calcium carbonate particles, it is possible to improve the results obtained with cosmetic products, especially rinse-out hair products, in terms of cosmetic properties and shaping properties. In particular, the hair is given texture (increased sensation of thickness) and better hairstyle hold.

Applicant's also argue:

"Additionally, under KSR, an "obvious to try" rationale for prima facie obviousness can only be supported when there is a "finite number of identified, predictable potential solutions to the recognized need or problem." M.P.E.P. §2143(E). Even a layperson, and certainly one of ordinary skill in the art, knows that personal care products vary widely in terms of formulation of ingredients depending on the desired use, texture, appearance, etc., and that not all ingredients will be compatible or interchangeable. The possible ingredients in hair compositions generally,

cannot be considered "finite" the way the term was used in KSR to describe the location of a sensor on a pedal. See, e.g., 82 USPQ2d at 1397. Further, one would not attempt to simply modify an optional cationic polymer or the amount of an optional insoluble compound listed in the '702 patent with specific groups taught in the '494 patent, WO '385, and WO '377, as suggested by the Examiner".

In response to the above argument, patent '702 at col.11, ll 41-45 suggests adding cationic conditioning polymers. See below.

Other Ingredients

In addition to the above noted compounds, various other ingredients can optionally be utilized in the stable composition of the present invention such as Fragrances, Perfumes, Preservatives, Disinfectants, Antioxidants, Antiredeposition Agents, Carriers, Chelating and Sequestering Agents, Dyes and Pigments, Quaternary Conditioners, Cationic conditioning polymers such as guar hydroxypropyltrimonium chloride, Polyquaternium-4, Polyquaternium-6, Polyquaternium-7, Polyquaternium-10, Polyquaternium-11, Polyquaternium-16, Polyquaternium-24, and Polyquaternium-39, Corrosion Inhibitors, Hydrotropes, Coupling Agents, Defoamers, Builders, Dispersants, Emollients, Extracts, Vitamins, Enzymes, Foam Boosters, Flocculants, Whitening Agents, Fixative Polymers such as PVP, Humectants, Opacifiers, Plasticizers, Powders, Solubilizers, Solvents, Waxes, UV Absorbers/UV Light Stabilizers, Hydrolyzed Proteins, Keratin, Collagens, and the like.

The function of cationic conditioning polymers is to provide conditioning benefit to the substrate, which can be any keratin containing substance. This knowledge is available to one of ordinary skill in the cosmetic art. The expression "optional" means the cationic conditioning polymer is present or the cationic conditioning polymer is absent in the compositions.

Applicant's attention is drawn to examples 1, which uses Guar Hydroxy propyl trimonium chloride (conditioner) and example 7, which uses Polyquaternium 7, examples 6-7 and , which uses Polyquaternium 39 and example 8, which uses Polyquaternium 10. The examples may not teach claimed polyethyleneimine as the cationic conditioning polymer but the examples definitely direct one skilled in the art to choose functional equivalent since substituting claimed cationic conditioning polymer for cationic conditioning polymer in the examples would also produce formulations that are stable and give conditioning property to the substrate.

Therefore one of ordinary skill in the art would be motivated to add the claimed polyethyleneimine (cationic polymer) of patent '494 into the compositions of '702 expecting that the compositions which has the acrylic acid/alkylacrylate polymer provides acceptable rheology without significant increased or decrease in viscosity or pH, with no separation settling with extended periods of time and adding the polyethyleneimine (cationic conditioning polymer) into the compositions provide conditioning effects which is excellent for the keratin and adding calcium carbonate particles of PG PUB would provide the additional benefit of better hair style hold and increased sensation of thickness to the hair.

In conclusion the claims are prima facie obvious within the meaning of 35 U. S. C. 103 over the combination of references cited above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30: 1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JYOTHSNA A VENKAT /
Primary Examiner, Art Unit 1619